

ADMINISTRATIVE PANEL DECISION

Canva Pty Ltd v. Hiep Vu
Case No. D2022-0186

1. The Parties

Complainant is Canva Pty Ltd, Australia, represented by SafeNames Ltd., United Kingdom.

Respondent is Hiep Vu, Viet Nam.

2. The Domain Name and Registrar

The disputed domain name <canvavietnam.com> is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 20, 2022. On January 20, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 21, 2022, the Registrar transmitted by email to the Center its verification response confirming that Respondent is listed as the registrant and providing the contact details, which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to Complainant on January 26, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on January 27, 2022.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified Respondent of the Complaint, and the proceedings commenced on February 1, 2022. In accordance with the Rules, paragraph 5, the due date for Response was February 21, 2022. Respondent sent informal email communications to the Center on February 19 and February 21, 2022. Accordingly, the Center sent the Commencement of Panel Appointment Process on February 23, 2022.

The Center appointed Ingrīda Kariņa-Bērziņa as the sole panelist in this matter on March 17, 2022. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and

Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

Complainant operates an online graphic design platform at the domain name <canva.com>. It is the proprietor of numerous registrations for its CANVA mark, including the following:

- Australia Trade mark registration No. 1483138 for CANVA (word mark), filed on March 29, 2012, registered on September 12, 2013 for goods in Class 9;
- United States Trademark No. 4316655 for CANVA (word mark), registered on April 9, 2013 for services in Class 42;

The disputed domain name was registered on March 13, 2020. It does not currently resolve to an active website. The record contains evidence that it previously resolved to a website offering Canva Pro software at a discounted rate.

5. Parties' Contentions

A. Complainant

Complainant's contentions may be summarized as follows:

Under the first element, Complainant states that it was founded in 2012. Users of Complainant's online graphic design platform use "drag and drop" methodology to create graphic designs. The platform has 30 million active monthly users and customers in 190 countries, and Complainant was valued at USD 6 billion as of June 2020. Complainant offers both a free basic service and a paid version named "Canva Pro", and also offers online tutorials. Complainant's CANVA mark is well known around the world. The disputed domain name contains Complainant's CANVA mark together with the geographic term "vietnam".

Under the second element, Complainant states that Respondent has no rights in the CANVA mark, and has not received permission from Complainant to use a domain name that incorporates the CANVA mark. The disputed domain name resolves to a website that mentions Complainant's mark and purports to offer Canva Pro software at a 70% discount. Respondent is using the disputed domain name to give an impression of association with Complainant's business. Respondent's website is commercial and is therefore not a "fan site".

Under the third element, Complainant states that its registration of the CANVA mark predates the registration of the disputed domain name by at least eight years. Complainant's marks and business are readily visible online. Complainant sent a cease-and-desist letter to which Respondent did not respond. Respondent also registered the domain name <canvavietnam.vn>, to which the disputed domain redirects, thereby demonstrating a pattern of bad faith conduct targeting Complainant.

Complainant requests transfer of the disputed domain name.

B. Respondent

Respondent provided informal email communications to the Center on February 19 and February 21, 2022, in which Respondent stated that he operates a website in connection with design training and wishes to retain the disputed domain name for this purpose. Respondent stated that Canva Pro is mentioned on the website to attract student interest, but that he does not distribute this software.

6. Discussion and Findings

Paragraph 4(a) of the UDRP requires Complainant to make out all three of the following:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (ii) Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) Respondent has registered and is using the disputed domain name in bad faith.

Under paragraph 15(a) of the Rules, “[a] Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable”.

A. Identical or Confusingly Similar

Complainant has provided evidence, not challenged by Respondent, establishing that it has trademark rights in the CANVA mark through registrations in numerous jurisdictions. Complainant thereby satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 1.2.

In comparing Complainant’s CANVA mark with the disputed domain name, the Panel finds that the disputed domain name is confusingly similar to it. The disputed domain name comprises Complainant’s mark in its entirety, followed by the term “vietnam”. It is the consensus view of UDRP panels that, where a domain name incorporates the entirety of a trademark, the domain name will normally be considered confusingly similar to that mark. Moreover, where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. See [WIPO Overview 3.0](#), sections 1.7 and 1.8.

It is the well-established view of UDRP panels that the addition of the generic Top-Level Domain (“gTLD”), in this case, “.com”, to a domain name is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test (see [WIPO Overview 3.0](#), section 1.11.1, and cases cited thereunder).

Accordingly, the Panel finds that Complainant has established the first element under paragraph 4(a) of the Policy.

B. Rights or Legitimate Interests

The circumstances stated in the Complaint and evidence in support set forth in the annexes thereto indicate that Respondent has no rights or legitimate interests in the disputed domain name.

The Panel finds that the evidence submitted by Complainant establishes a *prima facie* case that Respondent has no rights or legitimate interests in the disputed domain name. Respondent is not authorized by Complainant and is not commonly known by the disputed domain name. Furthermore, the disputed domain name comprises Complainant’s mark, with the addition of a geographic term, thereby creating a likely risk of connection with Complainant. Such holding of the disputed domain name cannot confer rights or legitimate interests. See [WIPO Overview 3.0](#), section 2.5.1.

Pursuant to [WIPO Overview 3.0](#), section 2.1, and cases thereunder, where Complainant makes out a *prima facie* case that Respondent lacks rights or legitimate interests, the burden of production on this element shifts to Respondent to come forward with relevant evidence demonstrating rights or legitimate interests in

the disputed domain name.

Respondent has not provided any rebuttal of Complainant's *prima facie* case and has therefore not proved rights or legitimate interests in the disputed domain name. There is no evidence that Respondent is commonly known by the disputed domain name, or that there are any circumstances or activities that would establish Respondent's rights therein. Rather, as Respondent admits, the disputed domain name resolved to a website featuring Complainant's mark and a mention of Complainant's Canva Pro product for the stated purpose of attracting Internet users for commercial gain. Such use cannot establish rights or legitimate interests. See, for example, [WIPO Overview 3.0](#), section 2.5.3.

Accordingly, the Panel finds that Complainant has established the second element under paragraph 4(a) of the Policy.

C. Registered and Used in Bad Faith

The Panel finds that Complainant has demonstrated Respondent's bad faith registration and use of the disputed domain name. Complainant provides uncontroverted evidence that its rights in the CANVA mark predate the registration of the disputed domain name by several years. The disputed domain name contains Complainant's CANVA mark together with the term "vietnam". UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. See [WIPO Overview 3.0](#), section 3.1.4. Respondent has not provided any information that would rebut this presumption.

The evidence provided by Complainant indicates that the disputed domain name resolved to a website that offered Complainant's product, which is an attempt to attract Internet users for Respondent's commercial gain. See, for example, *Schneider Electric SA v. Ningbo Wecans Network Technology Co., Ltd., Ningbo Eurosin International Trade Co., Ltd.*, WIPO Case No. [D2004-0554](#). Respondent failed to respond to Complainant's cease-and-desist letter Respondent's stated aim of using the disputed domain name to attract Internet users is precisely the type of use that is emblematic of bad faith under the Policy. The Panel finds that such circumstances indicate bad faith in registration and use of the disputed domain name.

The Panel therefore finds that Complainant has established the third element under paragraph 4(a) of the Policy.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <canvavietnam.com> be transferred to Complainant.

/Ingrīda Kariņa-Bērziņa/
Ingrīda Kariņa-Bērziņa
Sole Panelist
Date: March 31, 2022